



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,148	07/24/2003	David Ciancio	058420-005	9317
27805	7590	02/03/2009	EXAMINER	
THOMPSON HINE L.L.P. Intellectual Property Group P.O. BOX 8801 DAYTON, OH 45401-8801			HOEL, MATTHEW D	
ART UNIT	PAPER NUMBER			
		3714		
MAIL DATE	DELIVERY MODE			
02/03/2009	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/626,148	CIANCIO ET AL.
	Examiner Matthew D. Hoel	Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 September 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 and 26-55 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-24 and 26-55 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/136/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1 to 7, 9, 13, 15, 16, 20, 23, 24, 26 to 30, and 32 to 55 are rejected under 35 U.S.C. 103(a) as being obvious over Walker, et al. (U.S. patent 6,415,262 B1) in view of Gardenswartz, et al. (U.S. patent 6,055,573 A).

3. As to Claim 1: '262 teaches a method for operating a reward program (Abst.; 18:60-64; 19:28-46) comprising the steps of:

establishing a plurality of product categories (Figs. 6, 7); receiving an indication of selected ones of the product categories (indication indicated through customer purchased of items);

tracking a customer's purchases in at least the selected product categories over a

plurality of discrete purchase transactions (purchasers buys one gallon of milk per week, 20:17-36; subscription defined for year, 19:61-20:16); and providing a single reward to said customer based at least in part upon the customer's cumulative purchases in the selected product categories over a discrete period of time (Abst.; single offer disclosed, 18:60-64, 19:28-46). '573, however, discloses providing an award which varies at least in part on the monetary amount of the customer's purchases (minimum number of purchases made over a predetermined time period, 3:65-4:2), and takes place over a plurality of transactions in which the reward is accumulated but is not provided to the customer (reward for purchasing predetermined amount within a certain time period, 15:5-13, so reward will not be issued until the time period is over, the amount of purchases accumulate over the length of the time period). '573 teaches the reward varying based at least in part upon the cumulative discrete purchase transaction (if purchaser purchases minimum amount, such as two liters over a six-week period, the purchaser is given an option to buy three liters within six weeks and so on, 17:3-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the varying award withheld from the purchaser of '573 to the reward program of '262. The reward system of '262 is tied to specific categories of products (products 602-614 in categories C1-C6, Fig. 6, 7:20-28). The subscription of '262 is a discounted price lower than retail over a fixed period of time (retail prices 624, subscription prices 628, 7:25-30, Fig. 6; the subscription requires a minimum frequency of purchases over the duration of the subscription, Figs. 8 & 9, 8:5-12,39-47). This is analogous to '573's requirement that the purchaser buy a

minimum amount of a specific product category (in this case, specific categories of grocery products like those of '262, see Col. 15 generally) over a contract or subscription duration (15:5-40, esp. 15:12-17). The effect of this modification is that '573 increases the potential reward if the purchaser complies with the terms of the product subscription by offering a higher reward for higher performance during the next contract as outlined in 17:3-17). This has the advantage of providing higher potential rewards as an incentive the purchaser, and enhancing revenue for the seller by committing to the purchaser to higher purchasing levels of products the purchaser is likely to be interested in anyway based on past behavior.

4. As to Claim 24: '262 teaches a method for operating a reward program (Abst.; 18:60-64; 19:28-46) comprising the steps of:
establishing a plurality of product categories (Figs. 6, 7);
setting a purchase threshold;
receiving an indication of selected ones of the product categories as selected by a customer (indication indicated through customer purchased of items);
tracking said customer's purchases in at least the selected categories over a plurality of discrete purchase transactions (purchasers buys one gallon of milk per week, 20:17-36; subscription defined for year, 19:61-20:16);
at some time after the customer reaches the purchase threshold, calculating a reward based at least in part upon customer purchases in the selected categories; and
providing said reward to said customer (Abst.; single offer disclosed, 18:60-64, 19:28-46). '573 discloses providing an award which varies at least in part on the monetary

amount of the customer's purchases (minimum number of purchases made over a predetermined time period, 3:65-4:2), and takes place over a plurality of transactions in which the reward is accumulated but is not provided to the customer (reward for purchasing predetermined of amount within a certain time period, 15:5-13, so reward will not be issued until the time period is over, the amount of purchases accumulate over the length of the time period).

5. As to Claim 26: '262 teaches a system for tracking and calculating customer rewards (Abst.; 18:60-64; 19:28-46) comprising:

at least one computer programmed to track the amounts of customer purchases in a plurality of predetermined product categories (Figs. 6, 7) for a plurality of customers over a plurality of discrete purchase transactions (purchasers buys one gallon of milk per week, 20:17-36; subscription defined for year, 19:61-20:16), and to calculate a single reward for each customer based at least in part upon the customer cumulative discrete purchase transactions in selected ones of said predetermined product categories (Abst.; single offer disclosed, 18:60-64, 19:28-46). '262 tracks the monetary amounts of customer purchases (product price, required frequency of purchases, subscription deposit, 2:49-55). '573 teaches the reward varying based at least in part upon the cumulative discrete purchase transaction (if purchaser purchases minimum amount, such as two liters over a six-week period, the purchaser is given an option to buy three liters within six weeks and so on, 17:3-18).

6. As to Claim 33: '262 teaches a software device for operating on a computer and for tracking and calculating customer rewards (Abst.; 18:60-64; 19:28-46), the software

including:

a tracking module for tracking the amounts of customer purchases in a plurality of predetermined product categories (Figs. 6, 7) for a plurality of customers for a plurality of discrete transactions (purchasers buys one gallon of milk per week, 20:17-36; subscription defined for year, 19:61-20:16); and

a calculating module for calculating a single reward for each customer based at least in part upon the cumulative tracked plurality of discrete customer purchases in selected ones of said predetermined product categories (Abst.; single offer disclosed, 18:60-64, 19:28-46). '262 tracks the monetary amounts of customer purchases (product price, required frequency of purchases, subscription deposit, 2:49-55). '573 teaches the reward varying based at least in part upon the cumulative discrete purchase transaction (if purchaser purchases minimum amount, such as two liters over a six-week period, the purchaser is given an option to buy three liters within six weeks and so on, 17:3-18).

7. As to Claim 45: '262 teaches a method for operating a reward program (Abst.; 18:60-64; 19:28-46) comprising the steps of:

establishing a plurality of product categories (Figs. 6, 7); receiving an indication of at least one selected product category (indication indicated through customer purchased of items);

tracking a customer's purchases in the at least the selected product category over a plurality of discrete purchase transactions (purchasers buys one gallon of milk per week, 20:17-36; subscription defined for year, 19:61-20:16); and

providing a single reward to said customer based at least in part upon the customer's

cumulative purchases in the at least one selected product category over a discrete period of time (Abst.; single offer disclosed, 18:60-64, 19:28-46). '262 tracks the monetary amounts of customer purchases (product price, required frequency of purchases, subscription deposit, 2:49-55). '573 teaches the reward varying based at least in part upon the cumulative discrete purchase transaction (if purchaser purchases minimum amount, such as two liters over a six-week period, the purchaser is given an option to buy three liters within six weeks and so on, 17:3-18).

8. As to Claim 2: '262 teaches method of claim 1 wherein said receiving step includes receiving an indication of selected ones of the product categories as selected by a customer (products indicated by player's purchase, Abst.).

9. As to Claim 3: '262 teaches the method of claim 1 wherein said receiving step includes receiving an indication of selected ones of the product categories as selected by an operating store (subscriptions for complementary products selected by provider, Figs. 10 & 11, 8:48-9:32).

10. As to Claim 4: '262 teaches the method of claim 1 wherein said selected ones of said product categories are less than all of said plurality of product categories (other complementary subscriptions available, so the customer not subscribing to all available subscriptions, Fig. 16).

11. As to Claim 5: '262 teaches the method of claim 1 wherein said reward is based solely upon purchases by said customer in the selected categories (single offer disclosed, offer based only on the customer's purchase of milk in this case, 18:60-64, 19:28-46; 19:47-20:36).

12. As to Claim 6: '262 teaches the method of claim 1 wherein said tracking step includes tracking purchases of said customer in each of the plurality of product categories over a plurality of discrete purchase transactions (customer has plural subscriptions, Fig. 14; subscriptions involve plural transactions over a time period, 19:47-20:36).
13. As to Claim 7: '262 teaches the method of claim 1 wherein said receiving step occurs before the start of said tracking step (Figs. 10, 11, new complementary subscriptions defined based on current subscriptions, of course the player cannot take advantage of these subscriptions by making purchases until after the subscriptions have been defined, 8:48-9:32).
14. As to Claim 9: '262 teaches the method of claim 1 wherein said providing step includes providing a reward only if a customer has made sufficient purchases that exceed a purchase threshold (offers given, 18:60-64, 19:37-46; penalty assessed and reward not offered if minimum purchases are not made, 19:47-20:36).
15. As to Claim 13: '262 teaches the method of claim 1 wherein said reward is store credit, a coupon, a gift card, or a gift certificate (credit offered in the form of a lower price, 18:60-64, 19:37-46).
16. As to Claim 15: '262 teaches the method of claim 1 wherein further comprising the step of recognizing said selected product categories, said recognizing step including entering said selected product categories into a computer system (product categories and descriptions, Figs. 6 & 7, stored in database, Fig. 5).

17. As to Claim 16: '262 teaches the method of claim 15 wherein said recognizing step includes linking said selected product categories to a permanent customer account maintained beyond a specific transaction (customer records, Fig. 14, 11:4-30).
18. As to Claim 20: '262 teaches the method of claim 1 further comprising the step of receiving an indication of new selected ones of said products categories, and wherein said providing step includes providing a reward to said customer based at least in part upon the customer's purchases in the new selected categories (subscriptions for complementary products offered to user, Fig. 16; player accepts or declines subscription offers, Figs. 15A-B; reward offered to player for completion of subscription, 18:60-64, 19:34-20:15).
19. As to Claim 23: '262 teaches the method of claim 1 wherein said receiving, tracking, and providing steps are carried out for a plurality of customers (Fig. 14, customer identifiers indicate a plurality of customers).
20. As to Claim 27: '262 teaches the system of claim 26 wherein said computer is programmed to receive an indication of selected ones of said product categories as selected by a customer (complementary subscriptions offered to user, Fig. 16; can be accepted or declined by user, Figs. 15A-B; various product categories, Figs. 6 & 7).
21. As to Claim 28: '262 teaches the system of claim 26 involving receiving an indication of selected ones of the product categories as selected by an operating store (subscriptions for complementary products selected by provider, Figs. 10 & 11, 8:48-9:32).

22. As to Claim 29: '262 teaches the system of claim 26 wherein said computer is programmed to store a purchase threshold and to compare the cumulative purchases of each customer to the purchase threshold (minimum purchases for subscriptions, 19:61-20:37).
23. As to Claim 30: '262 teaches the system of claim 26 further including a plurality of checkout terminals located in at least one store and coupled to said at least one computer, wherein each checkout terminal can identify the products purchased by each customer and transfer such information to said at least one computer (POS terminals in store, Figs. 1-3, 4:17-45).
24. As to Claim 32: '262 teaches the system of claim 26 further including a database of customer information, said database including customer identifying information for each customer and reward information associated with each customer, said database being readable by said computer (Figs. 3-5, 14; POS controller 100, 4:31-45; database, 11:4-51).
25. As to Claim 34: '262 teaches the software device claim 33 wherein said tracking module can receive an indication of selected ones of said product categories as selected by a customer (products indicated by player's purchase, Abst.).
26. As to Claim 35: '262 teaches the software device of claim 33 wherein at least one of said tracking module or calculating module can store a purchase threshold and compare the cumulative purchases of each customer to the purchase threshold (minimum purchases required for subscription, 19:47-20:36).

27. As to Claim 36: '262 teaches the software device of claim 33 wherein said software device includes a computer readable medium and a computer program stored on the computer readable medium and including said tracking and calculating modules (database, Fig. 5; customer records, Fig. 14, 11:4-51).
28. As to Claim 37: '262 teaches the method of claim 1 wherein said receiving step is discrete and separate from a purchase transaction (Figs. 15A-B, 16, user selection of product category in the form of selecting a subscription is separate from the individual purchase).
29. As to Claim 38: '262 teaches the method of claim 1 wherein said reward to said customer is based upon a plurality of discrete transactions (rewards 18:60-64, 19:38-46; rewards based on plurality of purchases over period of subscription, 19:47-20:36).
30. As to Claim 39: '262 teaches the method of claim 1 wherein each product category in said establishing step includes a plurality of products linked together by a store or chain to thereby define each product category (plural products in category, Fig. 6; categories set by retail store, 7:19-38, exemplary grocery stores, 1:38-2:12).
31. As to Claim 40: '262 teaches the method of claim 39 wherein each product category includes a relatively broad category of products and includes a plurality of differing products or goods included therein such that each product category is broader than any particular product or good individually available for purchase (plurality of products in category, Fig. 6).
32. As to Claim 41: '262 teaches the method of claim 1 wherein said establishing step includes establishing, before a purchase transaction, a predefined number of

product categories, wherein each product category includes a plurality of products, and wherein the method further includes the step of, after said establishing step and prior to said receiving step, a customer selecting one of said product categories (categories established, Fig. 6; complementary offers determined and offered to player, Fig. 16; player accepts or declines category subscription offer, Figs. 15A-B).

33. As to Claim 42: '262 teaches the method of claim 1 wherein each discrete transaction constitutes a separate visit to the store or chain (20:16-36, purchaser subscribes to one gallon of milk per week, which will involve separate visits to the store).
34. As to Claim 43: '262 teaches the method of claim 1 wherein said discrete period of time is longer than the period of time to carry out a purchase transaction (discrete purchases over term of subscription, 19:47-20:36).
35. As to Claim 44: '262 teaches the method of claim 24 wherein said tracking step includes tracking a customer's purchases in at least the selected product categories over a plurality of discrete purchase transactions, and wherein said providing step includes providing a single reward to said customer based at least in part upon the customer's cumulative purchases in the selected product categories over a discrete period of time (18:60-64, 19:36-46, 19:47-20:36).
36. As to Claims 46, 48, and 49: '262 teaches the reward being directly provided to the customer (18:60-64, 19:28-46).
37. As to Claim 47: '262 indicates that the products are product categories that would be sold by a grocery store (Figs. 6, 7). The background of '262 indicates that Walker, et

al. intended for the tracking system to be used at least among grocery stores (1:33-2:12).

38. As to Claims 50 and 52: '573 teaches the reward varying based at least in part upon the cumulative discrete purchase transaction (if purchaser purchases minimum amount, such as two liters over a six-week period, the purchaser is given an option to buy three liters within six weeks and so on, 17:3-18). This reward provides an immediate and tangible financial benefit to the consumer even though the reward is not remitted until the end of the period, because purchaser can start purchasing at the higher rate right away.

39. As to Claim 51: Steps 1008 and 1010 of Fig. 10 ('573) deliver the reward to the purchaser without any further action on the part of the purchaser (16:30-38).

40. As to Claim 53: '573 teaches the reward varying based at least in part upon the cumulative discrete purchase transaction (if purchaser purchases minimum amount, such as two liters over a six-week period, the purchaser is given an option to buy three liters within six weeks and so on, 17:3-18).

41. As to Claim 54: '573 discloses providing an award which varies at least in part on the monetary amount of the customer's purchases (minimum number of purchases made over a predetermined time period, 3:65-4:2), and takes place over a plurality of transactions in which the reward is accumulated but is not provided to the customer (reward for purchasing predetermined of amount within a certain time period, 15:5-13, so reward will not be issued until the time period is over, the amount of purchases accumulate over the length of the time period).

42. As to Claim 55: The purchaser's reward is based on a monetary amount of the customer's purchase of a specific category over a discrete period of time, in this case buying soda over six-week period (15:5-13).

43. Claims 8, 12, 17 to 19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over '262 and '573 in view of Suzuki (U.S. patent 5,053,957 A).

44. As to Claim 8: The combination of '262 and '573 discloses all of the limitations of Claim 8, but lacks specificity as to receiving after tracking. It is, however, possible in '957 for the receiving step to be made after the tracking step in the event that the temporary change key in step 102 is pressed before the goods key 116 (customer level changed temporarily before transactions rung up, Col. 4, Lines 47 to 64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied this step found in '957 to the combination of '262 and '573. '262 teaches POSs (cash registers) connected to a database in a retail environment (Figs. 1-3, 4:17-45, 1:33-2:12), which is analogous to the cash register system of '957 (Abst.). The rewards of '262 can be lower prices for products or subscriptions (18:60-64, 19:37-45); the cash register of '957 implements discount levels corresponding to customer levels (Abst., Fig. 4, 3:1-21). This modification would be advantageous in that it would provide a convenient way to implement the discounts as they are done at the register and no manual overrides or manual calculations would be needed to provide the discounts.

45. As to Claim 12: '957 discloses printing on the customer's purchase receipt, the total amount of the customers purchases to date that qualify for awards (Fig. 16). '599

teaches rewarding the customer based on purchase levels to date (Fig. 5). '599 issues a periodic statement to the customer indicating the performance target, the target period, and the reward terms to the player (Col. 10, Lines 36 to 50).

46. As to Claim 17: '957 recognizes products by scanning a bar code (Col. 7, Lines 1 to 9).

47. As to Claim 18: '957 recognizes products marked with bar codes and recognizes which category they are in (Fig. 10; Col. 7, Lines 1 to 9).

48. As to Claim 19: '957 discloses printing on the customer's purchase receipt, the total amount of the customers purchases to date that qualify for awards (Fig. 16). '599 teaches rewarding the customer based on purchase levels to date (Fig. 5). '599 issues a periodic statement to the customer indicating the performance target, the target period, and the reward terms to the player (Col. 10, Lines 36 to 50).

49. As to Claim 31: '957 teaches a bar code scanner operatively coupled to at least one computer, wherein the bar code scanner can identify selected ones of the product categories (Col. 7, Lines 1 to 7).

50. Claims 10, 11, 14, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over '262 and '573 in view of Walker, et al. (U.S. patent 6,128,599 A).

51. As to Claim 10: The combination of '262 and '573 discloses all of the limitations of Claim 10, but lacks specificity as to a threshold being exceeded. '599, however, determines the reward based upon customer purchases in the selected categories after the purchase threshold is exceeded (Fig. 8, award distributed in step 820 after

determination of target achievement made in step 818). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the exceeded threshold of '599 to the combination of '262 and '573. '262 teaches that a minimum level of purchases must be made in order to obtain an award, which can take the form of a discount (19:47-20:36, 18:60-64, 19:37-46), so this is an analogous limitation to a threshold. This limitation thus appears to be a mere design consideration in light of '262. It would have the advantage of providing another criterion for awarding the rewards that the store or retail chain could use to customize the reward or customer tracking programs for maximum profitability.

52. As to Claim 11: The customer of '599 is notified after the purchase threshold has been exceeded (periodic statement, Col. 10, Lines 36 to 50).

53. As to Claim 14: The reward of '599 is based at least in part upon a percentage of all or a portion of the customer's purchases in each of the selected product categories (1% reward for purchases up to \$150,000 and 2% for over \$150,000).

54. As to Claim 21: '599 teaches providing an award based on purchases after a quarterly reward period is over (first row of table, Fig. 5).

55. As to Claim 22: '599 sets a target aggregate quarterly charge volume if the accessed aggregate quarterly charge volume is below a minimum (Col. 8, Line 60 to Col. 9, Line 29, especially Table I).

Claim Rejections - 35 USC § 101

56. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 to 55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Page 10 of the recent Bilski decision requires any claim, including method or process claims, to be drawn to a specific apparatus or to a transformation of matter from one form to another. The examiner notes that physical transformation is seldom found in class 705 (business methods) or class 463 (electronic games and business methods therefor). One particular way to tie a claim to a particular apparatus is to cite how the specific structure of the apparatus executes the specific steps of the process or method. Regarding independent method Claim 1, this could be done by citing how the processor of a computer, according to the software comprising computer-executable instructions on a computer-readable medium, establishes a plurality of product categories such as buy a store's marketing planner via input such as mouse, keyboard, or touchscreen, or selection by a customer or purchaser via the same types of input devices. The claim could further cite tracking the purchaser's purchases via a barcode scanner at a point-of-sale (POS) terminal. The claim could further cite that the computer's processor processes the input in the form of category selection and purchases in physical memory according to the rules of the business method software stored in memory, and in the event of a reward criterion being successfully accomplished, remitting the reward to the purchaser via a bill/coin hopper, credit/debit card writer, or electronic funds transfer over an electronic funds transfer network. The examiner notes that the "concrete, tangible, and useful test" is no longer used. Independent Claims 24 and 45 are methods with similar limitations to

Claim 1, so similar considerations will apply. Independent Claim 26 cites a system, with similar functionality to the method claims and cites a computer programmed to conduct method steps, so the structure is defined in terms of functionality. Claim 26 should still cite how the computer controls specific structure of the apparatus to perform the specific steps of the method. If the applicants intend for Claim 26 to be a system claim in the form of software, it should cite computer-executable instructions stored on a computer-readable medium that when executed by a computer, cause the computer to execute the steps of a statutory process or method, as outlined above for the method claim. The cited steps of such a method would still have to be tied to a particular apparatus, such as by citing how the specific structure of an apparatus executes the specific steps of the process or method. Independent Claim 33 cites a software device, so the software considerations outlined above for Claim 26 apply to this claim as well.

Response to Arguments

57. Applicant's arguments with respect to claims 1 to 55 have been considered but are moot in view of the new ground(s) of rejection. Regarding the applicants' comments on Page 11, none of the independent claims cite that the category selection is made by the purchaser. They do not cite who makes the selection. It appears from the claims that the selection is made by the vendor, though this is not cited in the claims. The rest of the applicants' comments pertain to how '262 does not teach the newly cited limitations. The examiner respectfully disagrees with the applicants as to the claims' condition for allowability.

Conclusion

58. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

59. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

60. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

61. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

62. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel
Patent Examiner
AU 3714

Peter Vo
Supervisory Patent Examiner
Art Unit 3714

/M. D. H./
Examiner, Art Unit 3714

/Peter DungBa Vo/
Supervisory Patent Examiner, Art Unit 3714